APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Joel K. Young	Examiner: Hoang Vu A Nguyen Ba
Serial No.: 10/621,153	Group Art Unit: 2421
Filed: July 15, 2003	Docket: 977.055US1

For: Network Systems and Methods to Pull Video

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 10, 2009, from the Final Rejection of claims 1, 3-25, 27-36 of the above-identified application, as set forth in the Final Office Action mailed on March 4, 2009.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $540.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, Digi International, Inc.

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2. RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed on May 12, 2009 for related Patent Application Serial No. 10/621,227, entitled "Network Systems and Methods to Push Video," filed July 15, 2003.

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3. STATUS OF THE CLAIMS

In accordance with 37 CFR 41.37(c)(1)(iii) requiring a statement of the status of all claims, pending and cancelled, Appellant submits the following:

The present application was filed on July 15, 2003, with claims 1-33.

A non-final Office Action was mailed October 4, 2007. In a Response to the non-final Office Action filed January 25, 2008, claims 2 and 26 were canceled and claims 34-36 were added. A final Office Action was mailed April 17, 2008. A non-final Office Action was mailed September 19, 2008. A second final Office Action was mailed March 4, 2009. Claims 1, 3-25, and 27-36 stand twice rejected, remain pending, and are the subject of the present Appeal.

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4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the final Office Action which was mailed March 4, 2009.

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5. SUMMARY OF CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal ...". Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

Aspects of the present inventive subject matter include, but are not limited to, NETWORK SYSTEMS AND METHODS TO PULL VIDEO.

Independent Claim 1 (FIGS. 1 and 2; page 3, line 15 - page 6, line 2)

Some of the embodiments claimed are related to a system (100), comprising: at least one video display (120), at least one video file server (130), at least one media server (140), and a web client (150).

Each video file server (130) includes a number of video files (132) that include video content to be selectively displayed on a video display (120). The media server (140) is connected to the video file server (130) over a network (110). Each media server communicates with one or more of the video displays (120).

The web client (150) communicates with each media server (140) through the network (110) to configure at least one playlist (145) in the media server (140) using a web browser, each playlist (145) including a list of identifiers (230) of video content in the video file server (130) and logical actions (210, 240) related to playing the playlist (145). The playlist (145) includes at least one track (220), wherein the track (220) includes an identifier (230) to select one or more of the number of video files and includes at least one logical action (240) related to playing the playlist (145).

A media server (140) is configured to execute the playlist (145) to control video content on the video display (120), pull video content over the network (110) from two or more video files according to the playlist (120), and convert the pulled video content into a video output signal suitable for display as a function of the logical actions (210, 240) in the playlist (145).

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Independent Claim 16 (FIGS. 5 and 2; page 8, line 11-page 8, line 27)

Some of the embodiments claimed are related to a media server (140) comprising a memory to store at least one playlist (145) and a processor (510). Each playlist (145) includes a list of identifiers (220) for video files, a file server location (230) for the video files and logical actions (520) related to playing the video content. Each video file including video content to be selectively displayed on at least one video display, and an identifier is included in a track. The logical actions (520) include direct controls over the presentation of the video content, and at least one logical action is included in a track.

The processor (510) executes software to execute the playlist (145) and retrieve the selected video content from two or more video files over a network (110) according to the playlist (145) and to function as a conversion agent to translate the selected video content (540) into a video signal suitable for display as a function of the logical actions (520) in the playlist (145).

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Independent Claim 25 (FIG. 6; page 8, line 27-page 9, line 3)

Some of the embodiments claimed are related to a method of distributing video information, comprising (610) from a first network location, configuring a playlist of video files, the video files being stored in at least one second network location connected to the first network location via the network and the playlist configured in a third location, wherein the playlist is configured at least in part by logging into the third location with a web browser, and (620) from the third network location, connected to the first and second network locations via the network, executing the playlist. The executing the playlist includes (630) pulling video content associated with two or more video files from the second network location over the network according to the playlist, translating the video content at the third network location into a video output signal suitable for display, and executing logical actions included in the playlist, wherein the playlist includes at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist.

Independent Claim 34 (FIGS. 1, 2, and 4: page 3, line 15 - page 6, line 2, and page 7 line 10 to page 8 line 10)

Some of the embodiments claimed are related to a system (400), comprising at least one video file server (130), a plurality of media servers (140), and a web client (150).

The video file server (130) includes a number of video files (132), each video file (132) including video content (134) to be selectively displayed. The plurality of media servers (140) communicatively coupled to the video file server (130) over a network (110). Each media server (140) is communicatively coupled to at least one video display (120).

The web client (150) communicates with each media server (140) through the network (110) to configure a playlist (145) on each media server (140) at least in part by logging into the media server (140) with the web browser (150). Each playlist (145) includes a list of identifiers of video content (134) in the video file server (140) and logical actions (210, 240) related to playing the playlist (145), wherein the playlist (145) includes at least one track (220), wherein the track (220) includes an identifier (230) to select one or more of the number of video files and includes at least one logical action (240) related to playing the playlist (145).

Each media server (140) is configured to execute the playlist (145) to control video content (134) on the video display, pull video content over the network (110) from two or more video files (132) according to the playlist (145), and convert the pulled video content into a video output signal suitable for display on the video display (120) as a function of the logical actions (210, 240) in the playlist.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to each of the appended claims and its legal equivalents for a complete statement of the invention.

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6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 25 and 27-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Taylor et al. (U.S. Publication No. 2002/0138641; hereinafter "Taylor").

II. Claims 1, 7-9, 14-18, and 23-24 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis et al. (U.S. Publication No. 2005/0028208; hereinafter "Ellis") in view of Taylor.

III. Claims 10, 19-20, and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor and further in view of Rodriguez et al. (U.S. Publication No. 2002/0007485; hereinafter "Rodriguez").

IV. Claims 3-6 and 11 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor and further in view of Pendakur et al. (U.S. Publication No. 2003/0135857; hereinafter "Pendakur").

V. Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor, further in view of Pendakur, and further in view of Brooks (U.S. Publication No. 2003/0056217).

VI. Claim 21 was rejected under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor, further in view of Rodriguez, and further in view of Brooks.

7. ARGUMENT

A)   Rejections under 35 U.S.C. § 102(e).

The Appellant traverses the rejection of claims 25 and 27-36 because a proper *prima facie* case of anticipation has not been established.

1)   The Applicable Law under 35 U.S.C. §102(e)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

A claim in dependent form shall be construed to incorporate by reference all of the limitations of the claim to which it refers. 35 U.S.C. § 112 ¶4. Thus, if a reference does not anticipate a base claim, the reference does not anticipate a claim that depends on the base claim.

2)   Discussion of the Rejection to Claims 25 and 27-36 as Being Anticipated by Taylor.

I.   Taylor does not teach each and every element recited in, or incorporated into, these claims.

Independent claim 25 recites in part a method of distributing video information including

from a first network location, configuring a playlist of video files, the video files being stored in at least one second network location connected to the first network location via the network and the playlist configured in a third location, wherein the playlist is configured at least in part by logging into the third location with a web browser.

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An example of the first network location is the web client described in the specification of the present Patent Application, an example of the second location is the video file server described in the specification, and an example of the third network location is the media server described in the specification.

The Final Office Action mailed March 4, 2009 (hereinafter "the Office Action") attempts to read the proxy server 420 and database 425 of Taylor as the first location, the media content server 405, 410, 415 as the second location, and the client 300 of Taylor as the third location (*see,* Office Action, pg. 10.)

The Office Action states that it is noted that, when Microsoft® Windows Media Player is launched (at the client 300), the www.windowsmedia.com page is displayed and in the Windows Media Interface and wherein a user can configure a playlist by clicking on the button "Library" on the menu bar (*see,* Office Action, pg. 10). Thus, the reasoning of the Office Action has the play list configured from the third location (the client) when a user logs in instead of from the first location (the proxy server). Thus, Taylor does not teach configuring a playlist of video files from a first network location.

Additionally, Applicant cannot find in Taylor any teaching of

> from a first network location, configuring a playlist of video files, the video files being stored in at least one second network location ... and the playlist configured in a third location, and from the third network location, ... executing the playlist, including: pulling video content associated with two or more video files from the second network location over the network according to the playlist,

as recited in claim 25.

Taylor states that the streaming media player on client 300 requests a media clip from proxy server 420 (*see,* Taylor, ¶0036). Thus, in Taylor, the client (the third location in the reasoning of the Office Action) plays a play list by requesting a clip from the proxy server (the first location). Taylor only states that a request can be redirected to the media content server (the second location) from the proxy server 420 (the first location) (*see,* Taylor, ¶0036). Thus, in Taylor the third network location does not pull video from the second network location.

The Advisory Action mailed May 13, 2009 states that the claimed "executing a playlist" is considered to be anticipated by Taylor in step 635 of FIG. 6. However, regarding step 635,

Taylor states in paragraph 0049 that the streaming media player on client 300 requests a media clip from proxy server 420 before the currently playing media clip finishes. Thus, in Taylor and in the reasoning of the Office Action, the third network location (client 300) does not pull video from the second network location (media content server), but instead requests video from the first location (the proxy server).

Independent claim 34 recites in part:

at least one video file server ... including a number of video files, each video file including video content to be selectively displayed, a plurality of media servers communicatively coupled to the video file server over a network, and a web client to communicate with each media server through the network to configure a playlist on each media server at least in part by logging into the media server with a web browser,

as recited in claim 34 and incorporated into claims 35 and 36.

In rejecting base claim 34, note that the Office Action reads the media content servers 405, 410, and 415 of Taylor onto the video file server of the claim, and the client 300 of Taylor onto the recited plurality of media servers (*see*, Office Action, pg. 13). Taylor states that a user (using client 300) uses a browser to connect to a media server, such as proxy server 420 (*see*, Taylor, ¶0035). Thus, in Taylor, the user and browser are at the client 300 rather than connected via a network (note the claimed media server *is the client 300* according to the Office Action). Therefore, Taylor does not teach a web client [configuring] a playlist ... by logging into the media server through a network using a web browser, and Taylor does not teach the structure recited in the claim.

The Advisory Action changes the position of the Office Action and instead attempts to read the proxy server onto the claimed media server and, with this interpretation, the Office considers that Taylor meets the requirements of claim 34 (*see*, Advisory Action, pg. 2). However, the proxy server of Taylor is not properly read onto the claimed media servers. Claim 34 recites in part that each media server is configured to convert the pulled video content into a video output signal suitable for display on the video display as a function of the logical actions of the playlist. However, Taylor states that a streaming media player is located at the client (*see*, Taylor, ¶0044). Thus, because the proxy server does not convert the pulled video content into a

video output signal suitable for display, the proxy server is not properly read onto the claimed media servers.

Independent claims 25 and 34 similarly recite:

wherein the playlist includes at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist.

The Office Action states that the claimed track is interpreted as a playlist played back using WMP, wherein the playlist includes identifiers (*see,* Office Action, pg. 10 carryover paragraph to pg. 11). However, the playlist in Taylor does not include a track as recited in the claims. Taylor states, in regard to FIG. 5, that play list 505 includes one or more references to media clips, such as reference 510, which may include media clip location information 515 and clip information 520 (*see,* Taylor, ¶0042). Media clip information 515 typically refers to a non-existent file or document on a proxy server, and clip information may include such things as title and author (*see,* Taylor, ¶0042). The claims recite that the track includes an identifier and at least one logical action related to playing the playlist. Thus, the play list of Taylor does not include a track as recited in base claims 25 and 34.

The Advisory Action states that the playlist of Taylor does include a track that includes a logical action related to playing the playlist (*see,* Advisory Action, pg. 2). The Advisory Action states that "retrieve Media Clip 1" is a logical action. Because the playlist does not say 'retrieve" it appears to Appellant that the Advisory Action is taking the position that merely including the track in a playlist is a logical action. However, the claim recites the track includes ... at least one logical action related to playing the playlist, as recited in the claim, and the playlist of Taylor does not include a logical action in the track.

Thus, Taylor does not provide each and every element recited in the claims, and a proper *prima facie* case of anticipation has not been established with respect to independent claims 25 and 27-36.

B)   Rejections under 35 U.S.C. § 103(a).

The Appellant traverses the rejection of these claims because a proper *prima facie* case of obviousness has not been established.

1)   The Applicable Law under 35 U.S.C. §103(a)

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claim at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Additionally, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. See *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir.2002). Additionally, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn.*

A showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed

subject matter is obvious under 35 U.S.C. § 103(a). *KSR International Co.*, p. 14, line 24 through p. 15, line 8. The court in KSR made it clear, however, that the "teaching, suggestion, or motivation" (TSM) test is only one tool that can be used to determine obviousness, noting that the Examiner or court simply has to "determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* p. 14, lines 5-17. The court in KSR further noted that "to facilitate review, this analysis [supporting a rejection under 35 U.S.C. § 103(a)] should be made explicit." *Id.*

Specifically, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *See KSR Int'l Co.*, p. 14, citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Even if adding an element to a prior art was obvious, that does not establish that the claimed invention encompasses obvious subject matter. *KSR Int'l. Co.*, p. 19, ¶ 1. Instead, the following factors can still be considered to determine whether a claimed invention at issue is nonobvious under 35 U.S.C. § 103(a): (1) whether the claimed invention yields more than predictable results (id. p. 12, ¶¶ 1-2); (2) whether there are technical difficulties in combining the prior arts, requiring substantial reconstruction or redesign (id. p. 19, ¶ 1); (3) whether the prior art cannot be upgraded to or teaches away from the claimed invention (id. p. 22, ¶ 2); (4) whether the prior arts have secondary factors which may 'dislodge' obviousness – "long felt and unresolved needs", "the failure of others", "commercial success" (id. p. 2, ¶ 3); and (5) whether the prior arts require elements of the invention to be read using hindsight to be relevant to the claimed invention (p. 17, ¶ 3).

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS

19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

In order to take into account the inferences which one skilled in the art would reasonably make, the examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made. *M.P.E.P.* § 2141.03 (citing *Environmental Designs, Ltd. v. Union Oil Co*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984)).

> The examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of Appellants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon Appellants' disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2141.03.

2) Discussion of the rejection of claims 1, 7-9, 14-18, and 23-24 under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor.

I. *Ellis and Taylor do not describe every element of claims 1 and 16:*

Independent claims 1 and 16 similarly recite in part, a

a media server configured to execute [or store] the playlist ... each playlist
including ... at least one track, wherein the track includes an identifier to select
one or more of the number of video files and includes at least one logical action
related to playing the playlist.

The Office Action concedes that Ellis does not disclose the recited playlist and track, but

states that the playlist and track is disclosed in Taylor because the claimed track is interpreted as

a playlist played back using WMP, wherein the playlist includes identifiers (*see,* Office Action,

pg. 15). However, as set forth above, the playlist in Taylor does not include a track as recited in

the claims. Taylor states, in regard to FIG. 5, that play list 505 includes one or more references

to media clips, such as reference 510, which may include media clip location information 515

and clip information 520 (*see,* Taylor, ¶0042). Media clip information 515 typically refers to a

non-existent file or document on a proxy server, and clip information may include such things as

title and author (*see,* Taylor, ¶0042). The claims recite that the track includes an identifier and at

least one logical action related to playing the playlist. Thus, the play list of Taylor does not

include the track recited in base claims 1 and 16.

Additionally, Applicant cannot find in Ellis with Taylor any disclosure teaching or

suggestion of

a web client to communicate with each media server through the network to
configure at least one playlist in the media server using a web browser, ... each
media server configured to execute the playlist to control video content on the
video display,

as recited in claim 1.

The Office Action reads the recited media server onto the set top box 248 of user

television equipment 244 (*see,* Office Action, pg. 8). However, Ellis relates to an interactive

television program guide (*see,* Ellis Abstract). Ellis states that the set top box 248 implements a

program guide for control by user input (*see,* Ellis, ¶¶0187, 0188). Thus, Ellis does not teach or

suggest a media server to execute the playlist to control video content on the video display, but

instead relates to a program guide to play a program according to user input. In Taylor, a user

(using client 300) uses a browser to connect to a media server, such as proxy server 420 and to

set preferences (*see,* Taylor, ¶0035). Thus, in Taylor, video content is again played according to

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user input. Thus, the proposed combination of Ellis with Taylor does not provides all of the elements of claim 1.

Therefore, at least for these reasons, Ellis and Taylor do not provide all the elements recited in independent claims 1and 16 or the elements incorporated into their dependent claims, and a proper *prima facie* case of obviousness has not been established with respect to claims 1, 7-9, 14-18, and 23-24.

II. *One of ordinary skill in the art would not reasonably be led to combine Ellis and Taylor:*

Ellis refers to an interactive television program guide. A user is provided with an opportunity to adjust program guide settings (*see,* Ellis, Abstract), and provides program listings (*see,* Ellis, ¶¶0111, 0112). The play list 505 in Taylor merely includes listings to one or more references to media clips (*see,* Taylor, ¶0042). Thus, the play list 505 of Taylor does not add anything to Ellis.

The Office Action states that it would have been obvious to one of ordinary skill to use the play list as taught in Taylor in Ellis because this would allow Ellis to provide a user with the capability to create a list of video clips or TV programs or movies to be played back in the order specified by the user, thereby enhancing the user's interactive TV experience. However, as set forth above, Ellis already provides a listing of available programs from which the user can choose. Presumably, because the user can only choose programs that are available, the user selected play list of Taylor would not add anything to the system of Ellis, but would provide a list already provided by Ellis. Thus, one of ordinary skill in the art at the time the present invention was made would not reasonably have been led to combine Ellis with Taylor.

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3) Discussion of the rejection of claims 10, 19-20, and 22 under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor and in further view of Rodriguez.

I. *Ellis, Taylor and Rodriguez do not describe every element of claims 1 and 16 incorporated into claims 10, 19-20, and 22:*

Claim 10 depends on base claim 1, and claims 19-20, and 22 depend on base claim 16. As set forth above, Ellis and Taylor fail to teach or suggest all of the elements of base claims 1 and 16 that are incorporated into the dependent claims. Rodriguez fails to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor, Logan and Rodriguez, among other things,

> a media server configured to execute [or store] the playlist ... each playlist
> including ... at least one track, wherein the track includes an identifier to select
> one or more of the number of video files and includes at least one logical action
> related to playing the playlist,

as similarly recited in claims 1 and 16 and incorporated into claims 10, 19-20, and 22.

II. *Ellis, Taylor and Rodriguez do not describe every element of claim 10:*

Dependent claim 10 recites in part "wherein the logical actions include a number of times to play the files." The Office Action concedes that this is not specifically disclosed in Ellis-Taylor, but states that this is taught in Rodriguez (*see,* Office Action, pg. 19).

However, the cited portion of Rodriguez refers to a rental period selection screen 110 and not to a number of times to play the files in a playlist (*see,* Rodriguez, ¶0051). The Advisory Action states that a number of times to play the files is found in ¶0005 of Rodriguez. Rodriguez in ¶0005 refers to Video on Demand. Thus, the number of times to play a video is up to a user and not determined by a logical action included in the playlist.

Therefore, at least for these reasons, Ellis, Taylor and Rodriguez do not provide all the elements recited in, or incorporated into, dependent claims 10, 19-20, and 22, and a proper *prima facie* case of obviousness has not been established with respect to these claims.

4)   **Discussion of the rejection of claims 3-6 and 11 under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor and in further view of Pendakur.**

I.   *Ellis, Taylor and Pendakur do not describe every element of claim 1 incorporated into claims 3-6 and 11:*

Claims 3-6 and 11 ultimately depend on base claim 1. As set forth above, Ellis and Taylor fail to teach or suggest all of the elements of base claim 1 that are incorporated into the dependent claims. Pendakur fails to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor and Pendakur, among other things,

> a media server configured to execute [or store] the playlist ... each playlist including ... at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist,

as presently recited in claim 1 and incorporated into claims 3-6 and 11. Therefore, Ellis, Taylor and Pendakur do not provide all the elements recited in, or incorporated into, dependent claims 3-6 and 11, and a proper *prima facie* case of obviousness has not been established with respect to these claims.

5)   **Discussion of the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor, in further view of Pendakur, and in further view of Brooks.**

I.   *Ellis, Taylor, Pendakur and Brooks do not describe every element of claim 1 incorporated into claims 12 and 13:*

Claims 12 and 13 ultimately depend on base claim 1. As set forth above, Ellis and Taylor fail to teach or suggest all of the elements of base claim 1 that are incorporated into the dependent claims. Pendakur and Brooks fail to teach or suggest the missing elements. For example, Applicant cannot find in the proposed combination of Ellis, Taylor, Pendakur and Brooks any teaching or suggestion of, among other things,

---

> a media server configured to execute [or store] the playlist ... each playlist
> including ... at least one track, wherein the track includes an identifier to select
> one or more of the number of video files and includes at least one logical action
> related to playing the playlist,

as recited in claim 1 and incorporated into claims 12 and 13. Therefore, Ellis, Taylor, Pendakur

and Brooks do not provide all the elements recited in, or incorporated into, dependent claims 12

and 13, and a proper *prima facie* case of obviousness has not been established with respect to

these claims.

6)   Discussion of the rejection of claim 21 under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Taylor, in further view of Rodriguez, and in further view of Brooks.

I.   Ellis, Taylor, Rodriguez and Brooks do not describe every element of claim 16 incorporated into claim 21:

Claim 21 ultimately depends on base claim 16. As set forth above, Ellis, Taylor and

Rodriguez fail to teach or suggest all of the elements of base claim 16 that are incorporated into

the dependent claims. Brooks fails to teach or suggest the missing elements. For example,

Applicant cannot find in the proposed combination of Ellis, Taylor, Rodriguez and Brooks,

among other things,

> a media server configured to execute [or store] the playlist ... each playlist
> including ... at least one track, wherein the track includes an identifier to select
> one or more of the number of video files and includes at least one logical action
> related to playing the playlist,

as presently recited in claim 16 and incorporated into claim 21. Therefore, Ellis, Taylor,

Rodriguez and Brooks do not provide all the elements recited in, or incorporated into, dependent

claims 12 and 13, and a proper *prima facie* case of obviousness has not been established with

respect to these claims.

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SUMMARY

For the reasons argued above, claims 25 and 27-36 were not properly rejected under 35 U.S.C. § 102(e) as being anticipated by Taylor. It is respectfully submitted that Taylor does not anticipate these claims.

For the reasons argued above, claims 1, 7-9, 14-18, and 23-24 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis and Taylor. It is respectfully submitted that Ellis and Taylor do not render these claims obvious.

For the reasons argued above, claims 10, 19-20, and 22 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Taylor and further in view of Rodriguez. It is respectfully submitted that Ellis, Taylor and Rodriguez do not render claims 10, 19-20, and 22 obvious.

For the reasons argued above, claims 3-6 and 11 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Taylor and further in view of Pendakur. It is respectfully submitted that Ellis, Taylor and Pendakur do not render claims 3-6 and 11 obvious.

For the reasons argued above, claims 12 and 13 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Taylor, further in view of Pendakur and further in view of Brooks. It is respectfully submitted that Ellis, Taylor, Pendakur and Brooks do not render claims 12 and 13 obvious.

For the reasons argued above, claim 21 was not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Taylor, further in view of Rodriguez, and further in view of Brooks. It is respectfully submitted that Ellis, Taylor, Rodriguez and Brooks do not render claims 12 and 13 obvious.

Therefore, reversal of the rejection and allowance of the pending claim are respectfully requested. If necessary please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date _Aug. 4, 2009_   By _Paul J. Urbanski_
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<u>**CERTIFICATE UNDER 37 CFR 1.8:**</u> The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of <u>August</u> 2009.

DAWN M. POOLE

_____   _____
Name   Signature

CLAIMS APPENDIX

1.   A system, comprising:

at least one video display;

at least one video file server, each video file server including a number of video files, each video file including video content to be selectively displayed on the at least one video display;

at least one media server connected to the video file server over a network, each media server to communicate with one or more of the at least one video display;

a web client to communicate with each media server through the network to configure at least one playlist in the media server using a web browser, each playlist including a list of identifiers of video content in the video file server and logical actions related to playing the playlist, wherein the playlist includes at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist; and

each media server configured to:

execute the playlist to control video content on the video display,

pull video content over the network from two or more video files according to the playlist, and

convert the pulled video content into a video output signal suitable for display as a function of the logical actions in the playlist.

2.   (Canceled)

3.   The system of claim 1, wherein the logical actions execute in the media server as a decision tree.

4.   The system of claim 3, wherein the media server executes the at least one playlist based on the logical actions in the playlist, and wherein the logical actions are configured at least in part by the web client.

5.   The system of claim 4, wherein the logical actions are configured at least in part in real time by a user using the web client.

6.   The system of claim 4, wherein logical actions further include inputs external to the media server.

7.   The system of claim 1, wherein the logical actions further include a timed duration of playing the files.

8.   The system of claim 1, wherein the logical actions further include a time to initiate playing the files.

9.   The system of claim 1, wherein the logical actions further include a time to terminate playing the files.

10.   The system of claim 1, wherein the logical actions further include a number of times to play the files.

11.   The system of claim 6, wherein the inputs external to the media server are mapped into application specific commands according to the format of the video file.

12.   The system of claim 11, wherein the inputs external to the media server include a motion sensor.

13.   The media server of claim 11, wherein the inputs external to the media server include a proximity sensor.

14.   The system of claim 1, wherein the video file further includes audio content.

15.   The system of claim 1, wherein the video content includes any combination from the set of Power Point, J-Peg, Video Clip, or Web formats.

16.   A media server, comprising:

a memory to store at least one playlist, each playlist including:

a list of identifiers for video files, each video file including video content to be selectively displayed on at least one video display, wherein an identifier is included in a track;

a file server location of the video files; and

logical actions related to playing the selected video content, wherein the logical actions include direct controls over the presentation of the video content, wherein at least one logical action is included in a track; and

a processor executing software to execute the playlist and retrieve the selected video content from two or more video files over a network according to the playlist and to function as a conversion agent to translate the selected video content into a video signal suitable for display as a function of the logical actions in the playlist.

17.   The media server of claim 16, wherein the processor executes the at least one playlist based on the logical actions and wherein the logical actions depend in part on inputs external to the media server.

18.   The media server of claim 17, wherein the inputs external to the media server are mapped into application specific commands depending on the format of the video file.

19.   The media server of claim 18, wherein the application specific commands include any combination from the set of Play, Restart, Pause, Stop, Rewind, Fast Forward, Next File, Next Slide, Previous Slide, Mouse Click, Hyperlink and Go To New Playlist.

20.   The media server of claim 19, wherein the inputs external to the media server include messages received from the network.

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21.   The media server of claim 19, wherein the inputs external to the media server include one of a proximity sensor and a motion sensor.

22.   The media server of claim 19, wherein the inputs external to the media server include a prompt.

23.   The media server of claim 16, wherein the at least one playlist is stored on the media server.

24.   The media server of claim 16, wherein the media server includes a memory capable of storing a video file.

25.   A method of distributing video information, comprising:

from a first network location, configuring a playlist of video files, the video files being stored in at least one second network location connected to the first network location via the network and the playlist configured in a third location, wherein the playlist is configured at least in part by logging into the third location with a web browser; and

from the third network location, connected to the first and second network locations via the network, executing the playlist, including:

pulling video content associated with two or more video files from the second network location over the network according to the playlist;

translating the video content at the third network location into a video output signal suitable for display; and

executing logical actions included in the playlist, wherein the playlist includes at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist.

26.   (Canceled)

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27.   The method of claim 25, wherein executing logic actions includes the third location receiving external inputs that are mapped into application specific commands.

28.   The method of claim 27, wherein executing logic actions includes the third location receiving logic actions from the first location.

29.   The method of claim 27, wherein the application specific commands include any combination from the set of Play, Restart, Pause, Stop, Rewind, Fast Forward, Next File, Next Slide, Previous Slide, Mouse Click, Hyperlink and Go To New Playlist.

30.   The method of claim 25, wherein the first network location includes a web client.

31.   The method of claim 25, wherein the second network location includes a video file server.

32.   The method of claim 25, wherein the third location includes a media server.

33.   The method of claim 32, wherein the first network location includes a computer and configuring a playlist includes:

    downloading an existing playlist from the media server at the third location to the computer;

    editing the playlist; and

    uploading the edited playlist from the computer to the media server.

34.   A system, comprising:

    at least one video file server, the video file server including a number of video files, each video file including video content to be selectively displayed;

    a plurality of media servers communicatively coupled to the video file server over a network, each media server communicatively coupled to at least one video display;

a web client to communicate with each media server through the network to configure a playlist on each media server at least in part by logging into the media server with a web browser, each playlist including a list of identifiers of video content in the video file server and logical actions related to playing the playlist, wherein the playlist includes at least one track, wherein the track includes an identifier to select one or more of the number of video files and includes at least one logical action related to playing the playlist; and

each media server configured to:

execute the playlist to control video content on the video display;

pull video content over the network from two or more video files according to the playlist; and

convert the pulled video content into a video output signal suitable for display on the video display as a function of the logical actions in the playlist.

35.   The system of claim 34, including a plurality of video file servers communicatively coupled to the network, wherein a media file server is configured to pull video content over the network from more than one video file server according to a video file server identifier included in the playlist.

36.   The system of claim 34, wherein the web client is configured to access the playlist on a media server interactively while the playlist is executing.

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EXHIBIT APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

No decisions have been rendered in the Appeal Brief filed July 9, 2009 for related Patent Application Serial No. 10/621,227, entitled "Network Systems and Methods to Push Video."